

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

P2009US00

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Signature _____

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Application Number

10/788,429

Filed

February 27, 2004

First Named Inventor

Sun-Dong LEE

Art Unit

2617

Examiner

CASCA, Fred A.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/hae-chan park/

Signature

☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Hae-Chan Park

Typed or printed name

☒ attorney or agent of record. 50,114

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703-288-5105

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☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

April 24, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Sun-Dong LEE

Serial No.: 10/788,429

Confirmation No.: 6998

Filed: February 27, 2004

Docket No.: P2009US00

Group Art Unit: 2617

Examiner: CASCA, Fred A.

For: **SYSTEM AND METHOD FOR ALARMING AN INCOMING MESSAGE OF A MOBILE COMMUNICATION TERMINAL**

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Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

I. In response to the Final Office Action of December 26, 2008 ("Office Action") and the Advisory Action of April 16, 2009 ("Advisory Action"), Applicant requests review of this application before filing an appeal brief because the rejections are improper and without merit.

II. All pending claims stand rejected as allegedly unpatentable over U.S. Patent Application Publication No. 2002/0111167 ("Nguyen") in view of U.S. Patent Application Publication No. 2003/0176205 ("Oota"), further in view of U.S. Patent No. 6,493,431 ("Troen-Krasnow"), and still further in view of U.S. Patent Application Publication No. 2003/0092454 ("Halim"). Applicant respectfully traverses this rejection for at least the following reasons.

III. First, the cited references do not render the present invention obvious because, even assuming that the cited references may be combined, the combined references fail to disclose or suggest all features of independent claims 1, 8, 11, and 18.

Claim 1

Claim 1 recites, in relevant part:

a messenger service system ...to send a second notification message to a personal computer, the second notification message to provide notification that the called mobile communication terminal is receiving the incoming message. (emphasis added)

Nguyen, Oota, Troen-Krasnow, and Halim, either alone or in combination, fail to disclose these features. The examiner concedes that the combination of Nguyen, Oota, and Troen-Krasnow "does not specifically disclose the second message for providing notification that the called mobile communication terminal is receiving the incoming message." Office Action, page 4 (emphasis in original).

To remedy the shortcomings of these references, the examiner then looks to Halim, and states that "Halim discloses sending ACKs when an SMS message is delivered to a user." Office Action, page 5 (emphasis in original). Applicant disagrees. To the contrary, Halim explains that "the Delivery ACK or Manual ACK [is] transmitted by the mobile station 10 after message presentation to a user." Halim, paragraph [0043] (emphasis added). Halim's paragraph [0038] offers the examiner no additional leverage, and explains that "the Delivery ACK is intended to be transmitted when a corresponding SMS message, which specifies Delivery ACK, is displayed to the user." (emphasis added). Thus, in Halim, the Delivery ACK is sent upon message display or presentation, is not "notification that the called mobile communication terminal is receiving the incoming message," and therefore fails to remedy the identified shortcomings of Nguyen, Oota, and Troen-Krasnow.

Reply to Examiner's Response to Arguments

The examiner does not appear to refute Applicant's position regarding Halim, and instead concludes that Halim's disclosure "would enable a person of ordinary skill in the art to modify the combination in the format claimed by applicant." Office Action, page 12. The

purpose for this modification would have been to “serve the same purpose as applicant’s second message.” *Id.* This basis for modifying Halim, and the modification itself cannot be maintained. First, the examiner has acknowledged a shortcoming in Halim, and attempts to remedy the shortcoming by concluding, without support or even an explanation, that a person of ordinary skill in the art could have further modified Halim beyond what it explicitly discloses. *Id.* Second, in contradiction of obviousness-type rejection principles, the examiner has relied upon nothing more than pure hindsight as a reason that would have prompted that person of ordinary skill in the art to combine the prior art elements in the manner claimed. *Id.* Thus, the examiner’s acknowledgement of Halim’s shortcoming remains unresolved.

Moreover, when citing to Halim, the examiner fails to note that in the well-known “concept of sending ACKs and NAKs,” an ACK message confirms delivery of the SMS message to the sending device of the original SMS message and not to another device, such as a personal computer. Halim, paragraph [0038] (disclosing that the ACK is sent back to the SMS message sender if the “SMS message, which specifies Delivery ACK, is displayed to the user.”). There would have been no reason to modify the concept of “sending the second notification messages to a personal computer,” as allegedly disclosed by the combination of Nguyen, Oota, and Troen-Krasnow, with Halim’s ACK message, which reports delivery confirmation to a message sender. This shortcoming is relevant because the examiner looks to Troen-Krasnow to disclose sending the incoming call notification message to a personal computer operated by the intended message recipient. Office Action, page 4. Since Halim’s ACK message is sent to the message sender, rather than to a personal computer operated by the intended message recipient, there would have been no reason to modify the combination of Nguyen, Oota, and Troen-Krasnow with Halim’s ACK message to obtain the elements in the manner claimed in claim 1.

Claims 8, 11, and 18

For at least these same reasons, Applicant respectfully submits that the cited references fail to disclose or suggest all features of claims 8, 11, and 18, each of which recite, in relevant part, that the called mobile communication terminal "is receiving" the incoming message.

IV. The cited references also fail to render the present invention obvious in view of the scope and contents of the prior art. Specifically, in combining Nguyen, Troen-Krasnow, Oota, and Halim, the examiner has examined discrete elements of claims 1, 8, 11, and 18 in isolation without considering the invention as a whole. Indeed, the Office Action offers no explanation how Oota's incoming-call notifying function could be used to modify Nguyen's system, which sends a message to a user before an incoming call is received, and Troen-Krasnow's system, which sends a message after an incoming call is missed.

For example, the examiner relies on Oota to disclose "first and second notifications [that] are different from each other." Office Action, page 3. However, in Oota, the timings of the first and second notifications are also different. Specifically, the first notifying section is "for notifying an incoming call," while the second notifying section is "for notifying an unanswered incoming call" that has been canceled by the network. Oota, paragraph [0008]. The examiner explains that it would have been obvious to incorporate Oota's two notifications with Nguyen on the basis that "the user may be more responsive to the second type of notification, e.g., the user may have hearing impairment." Office Action, page 3. But this conclusion ignores the distinct purposes of Oota's two notifying sections, since the second notifying section emits light after an incoming call was canceled. Thus, Applicant traverses the examiner's conclusion that incorporating Oota's two notifications into Nguyen would have "increas[ed] the possibility of response by the user." Office Action, page 3. Oota's second notifying section would not have increased the possibility of response by the user because the second notifying section notifies a user that a call was already missed.

Further, the Office Action offers no explanation how Oota's incoming-call notifying function, Nguyen's system, which sends a message to a user before an incoming call is received, and Troen-Krasnow's system, which sends a message after an incoming call is missed, could be combined with Halim's Delivery ACK message, which is transmitted after the SMS message intended for a user is actually displayed or presented to the user.

Finally, the Office Action also fails to provide a valid reason why and the way in which Halim could be modified to be compatible with the combination of Nguyen, Oota, and Troen-Krasnow, so that Halim's Delivery ACK message, which is normally sent back to a message sender, would provide "notification [to a personal computer] that the called mobile communication terminal is receiving the incoming message."

In rejecting the present claims, the examiner has failed to consider how these four references with distinct purposes could be combined into a single system that would render claims 1, 8, 11, and 18 obvious when considered as a whole.

V. For at least these reasons, Applicants requests withdrawal of the rejections of independent claims 1, 8, 11 and 18, and all the claims that depend therefrom because the rejections of record discussed above are clearly not proper and are without basis. Prompt and favorable consideration of this Pre-Appeal Brief Request for Review is respectfully requested.

Respectfully submitted,

/hae-chan park/

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Date: April 24, 2009

CUSTOMER NUMBER: 58027